UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,508	12/18/2003	Frederick W. Ryan Jr.	F-684-O1	1507

919   7590   01/03/2007
PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER
JABR, FADEY S

ART UNIT	PAPER NUMBER
3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/707,508	RYAN ET AL.
	Examiner	Art Unit	
	Fadey S. Jabr	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *7/27/06*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 12212006

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims **2, 16 and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claims 2, 16 and 19**, the recitation "a visible portion....a non visible portion" are vague and indefinite. It is unclear to the Office what the visible and non-visible *portions* are segments of. Appropriate correction is required in the indicated claims and any subsequent claims.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claim **1 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al., U.S. Patent No. 6,233,565 B1.

As per **Claim 1**, Lewis et al. discloses a method comprising:

- receiving a request relating to the first image from a client system (C. 19, line 36 – C. 20, line 10);

- providing data to the client system for forming at least a portion of a sample image to a portion of a program window in the client system that is visible to the user (C. 19, line 36 – C. 20, line 10); and

- providing data to the client system for forming at least a portion of the first image to a portion of the client system program window that is not visible to the user (C. 19, line 36 – C. 20, line 10).

As per **Claim 22**, Lewis et al. further discloses providing a mechanism to control printing of at least a portion of the client system program window that is not visible to the user (C. 19, line 52 – C. 20, line 10).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims **2, 4-5, 8, 10-14, 16-17, 19-21 and 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent No. 6,233,565 B1.

As per **Claim 2**, Lewis et al. discloses a method wherein:

- the first image comprises a shipping label having a postage indicia comprising a postage indicia code (C. 19, line 36-67; C. 35, lines 63-67);

- the sample image comprises a sample shipping label having a sample postage indicia (C. 19, line 36-67; C. 35, lines 63-67);

- the client system comprises a web browser application (C. 11, lines 20-27);

- the web browser application provides a visible portion for displaying a first frame including the sample image

- the data provided to the client system program is provided by a first web server (C. 11, lines 20-27; C. 19, line 36 - C. 20, line 10).

Lewis et al. fails to *explicitly* disclose the web browser application provides a non-visible portion for displaying a second frame including the first image. However, Lewis et al. discloses the system permits the user to preview a single envelope or label by pressing a Print Preview button. This will cause the return address, the mailing address, and a bitmap of a sample indicium to be displayed as it would appear printed. Pressing this button will pass control to a standard Print Preview screen. Pressing this button will pass control to a standard Print Preview screen. Pressing Print All causes a connection to be made to the web server and a file of addresses sent (C. 10, lines 52-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Lewis et al. and include a second frame of the label, as it will be printed, because it provides the system with a digital signature to verify the indicium before being printed.

As per **Claim 4-5**, Lewis et al. fails to *explicitly* disclose providing formatting

instructions to the client system, wherein the formatting instructions prevent user access to the

second frame. However, Lewis et al. discloses encrypting the indicium for the client to decrypt.

The indicium is encrypted to prevent unauthorized capture of the indicium (C. 20, lines 3-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to modify the method of Lewis et al. and include preventing user access to the actual

(i.e. non-sample) label, because it prevents unauthorized capture of the indicium.

As per **Claim 8**, Lewis et al. discloses the sample image has the same dimensions as the

first image (C. 19, lines 52-56).

As per **Claim 10**, Lewis et al. discloses

- providing a first logic indicator in the visible portion of the client system program

    window for receiving an indication of a sample print request (C. 19, lines 36-67); and

- providing a second logic indicator in the visible portion of the client system program

    window for receiving an indication of a non-sample print request (C. 19, lines 36-67).

As per **Claim 11**, Lewis et al. discloses receiving at least one indicator indicating whether

the non-sample print request was successful (C. 20, lines 11-19; C. 32, lines 63-67).

As per **Claim 12**, Lewis et al. fails to *explicitly* disclose determining whether the received

indicators indicate that a threshold of print failures has been reached, providing an indication that

the print request is invalid. However, Lewis et al. discloses once a transaction is completed,

transaction server creates a response transaction which is digitally signed with the digital

signature of the customer requesting the transaction, encrypted, and sent to the Host confirming

the success or failure of the transaction. The host then updates its local information to reflect

changes in postage available. Further, Lewis et al. discloses a screen containing two postage

threshold entry fields. Optionally, log postage can be selected, which the user can use for

accounting purposes (C. 18, lines 1-19; C. 32, lines 63-67). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of applicant's invention to modify the

method of Lewis et al. and include providing an indication when the transaction was successful

or failed, because it allows the system to update its local information to reflect changes in

postage available.

As per **Claim 13**, Lewis et al. discloses the first logic indicator and second logic indicator

are presented in a second visible frame (C. 19, lines 36-67).

As per **Claim 14**, Lewis et al. discloses

-   the first image includes image portions obtained from a second web server (C. 19,

    line 36 – C. 20, line 10); and

-   the sample image comprises image portions obtained from a second web server (C.

    19, line 36 – C. 20, line 10).

As per **Claim 17**, Lewis et al. discloses wherein

- the document of value comprises a document selected from the group: ticket, receipt, article, report, financial instrument and contract (C. 38, lines 40-47).

As per **Claim 20**, Lewis et al. discloses the sample image is a portion of the document of value (C. 19, lines 36-67; C. 38, lines 40-47).

As per **Claim 21**, Lewis et al. discloses the sample image is an article abstract (C. 19, lines 36-67; C. 38, lines 40-47).

As per **Claims 23-25**, Lewis et al. further discloses providing a mechanism to control printing of at least a portion of the client system program window that is not visible to the user (C. 19, line 52 – C. 20, line 10).

7.   Claims **3, 6-7, 9, 15 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent No. 6,233,565 B1 in view of Bussell, Pub. No. US 2002/0110397 A1.

As per **Claims 3, 7, 9 and 18**, Lewis et al. fails *explicitly* to disclose a sample shipping label includes a sample indicator. However, Lewis et al. discloses a print preview screen displaying a sample label (C. 19, lines 52-67). Further, Bussell teaches a sample label with a **void** indicator on the label obscuring the barcode to indicate the label is not usable for mailing

(see Figures 8-10). Therefore, it would have been obvious to one of ordinary skill in the art at

the time of applicant's invention to modify the method of Lewis et al. and include an void

indicator on the sample label as taught by Bussell, because it prevents users from attempting to

use fraudulent labels to send mail items.

As per **Claim 6**, Lewis et al. discloses the sample image is an image file using an image

file format selected from the group: GIF, BMP, TIFF, JPEG, PIX, PNG and PCX (C. 19, lines

36-67). Lewis et al. fails to disclose the sample indicator comprises an overlay for obscuring the

postage indicia of the sample label. However, Bussell teaches a sample label with a **void**

indicator on the label obscuring the barcode to indicate the label is not usable for mailing (see

Figures 8-10). Therefore, it would have been obvious to one of ordinary skill in the art at the

time of applicant's invention to modify the method of Lewis et al. and include an void indicator

on the sample label as taught by Bussell, because it prevents users from attempting to use

fraudulent labels to send mail items.

As per **Claim 15**, Lewis et al. fails to disclose wherein the formatting instructions prevent

scrolling and resizing of the client system program window. However, Bussell teaches a print

internet postage screen where the program window cannot be resized and does not have scroll

bars (see Figure 12). Therefore, it would have been obvious to one of ordinary skill in the art at

the time of applicant's invention to modify the method of Lewis et al. and include preventing a

user from resizing or scrolling a program window, because it prevents the user from distorting

the displayed image of the label which is to be printed.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

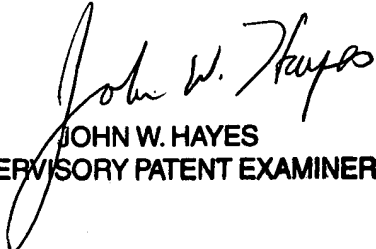Fadey S Jabr
Examiner
Art Unit 3628

FSJ

        Please address mail to be delivered by the United States Postal Service (USPS) as
follows:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

    (571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401
Dulany Street, Alexandria, VA 22314

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER